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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,547	01/24/2001	Masaru Kawai	30681-1005	8985
5179 7590 12/01/2004 PEACOCK MYERS AND ADAMS P C P O BOX 26927 ALBUQUERQUE, NM 871256927			EXAMINER HAMLIN, DERRICK G	
			ART UNIT 1751	PAPER NUMBER

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/674,547

**Applicant(s)**KAWAI ET AL. A**Examiner**

Derrick G. Hamlin

**Art Unit**

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☒ Claim(s) 3-31 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/04</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Request for Continued Examination***

1. The request filed on 11/05/04 for a Request Continued for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/674,547 is acceptable and a RCE has been established. An action on the RCE follows.

### ***Status of Claims***

2. Claims 1-31 are currently pending.
3. The rejection of claim 1 under 35 U.S.C. 112, second paragraph, is withdrawn in view of the applicant's amendment.
4. The rejection of claims 1-31 under 35 U.S.C. 103(a) as being unpatentable over Burns et al. (5085793), is withdrawn in view of the applicant's amendment.
- 5.

### ***Priority***

6. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/JP98/02024, filed on 5/6/1998.

## **NEW GROUNDS FOR REJECTION**

### ***Specification***

Art Unit: 1751

7. Claims 11, 14, 17, 21, 24 and 27 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may not depend on another multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 14, 17, 24 and 27 will not be further treated on the merits. Applicant previously removed the grounds for this rejection, however the applicant added the limitations that were objected to in the amendment filed 6/17/04.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Evaluations of level of ordinary skill in the art requires consideration of factors such as various prior art approaches employed, types of problems encountered in the art, rapidity with which innovations are made, sophistication of technology involved, educational background of those actively working in the field, commercial success, failure of others, and the inventor's educational level.

The "person having ordinary skill" in this art has the capability of understanding the scientific and engineering principles applicable to the claimed invention. The references of record in this case reasonably reflect this level of skill.

8. Claims 1 and 2 are rejected under 35 U.S.C. 102 (b) as being anticipated by Conner et al. (US 5,643,493).

Art Unit: 1751

Conner discloses a corrosion inhibitor concentrate, and a method for preparation thereof, which may be formulated free of nitrites, nitrates, amines, and phosphates. The inhibitor concentrate is a "single part" synergistic combination of inhibitors, stabilizers, and antifoam agents, useful for reinhibition of recycled antifreeze/coolant. The inhibitor concentrate is efficacious for corrosion inhibition in coolants across a broad range of glycol quality. The inhibitor concentrate comprises specific amounts of water, triazole, alkali metal hydroxide, borate, alkali metal silicate, silicate stabilizer, and anti-foaming agent. (abstract) The corrosion inhibitor concentrate of this invention may then be mixed with alcohol freezing depressants such as ethylene glycol, polypropylene glycol and mixtures thereof, to form a corrosion inhibited engine coolant formulation. (col. 5, lines 58-61) The corrosion inhibitor concentrate of this invention requires an amount of water from 20 to 90 weight percent (wt %). Preferably, the water is substantially free of metal ions, chlorides, sulfates, carbonates, or other undesirable contaminants. More preferably, the water is distilled, deionized, and/or an equivalent thereof. (col. 2, line 67 - col. 3, lines 8)

The reference is anticipatory.

In view of the forgoing, the above claims have failed to be patently distinguishable over prior art.

The remaining references listed on form(s) 892 and/or 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.

***Allowable Subject Matter***

9. Claims 3-13, 15, 16, 18-23, 25, 26 and 28-31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Conners is relied upon for the reasons set forth above. Additionally, Table 1 discloses several compounds that were present in the invention and the amounts used for the specific ethylene glycol disclosed (A-G), (col. 9, lines 10-35) however none of the references cited teach the combinations in the required amounts in a method as instantly claimed.

***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Claims 1 and 2 could also be rejected over Goddard et al (5,073,283 A).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick G. Hamlin whose telephone number is (571) 272-1317. The examiner can normally be reached on Monday-Fridays from ~8:30 AM to 5:00 PM.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta, can be reached on (571) 272-1316. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1751

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Derrick G. Hamlin

11/28/04



NECHOLUS OGDEN  
PRIMARY EXAMINER